

Appl. No. 09/920,583
Amdt. Dated 12/11/2006
Reply to Office action of 09/20/2006

RECEIVED
CENTRAL FAX CENTER

DEC 11 2006

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed September 20, 2006. In the Office Action, claims 1, 3-13, 15-26, 28-38, 45 and 47-52 stand rejected under 35 U.S.C. § 103.

Applicants have amended independent claims 1, 13, 26, and 45 to clarify embodiments of the invention.

Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Rejections Under 35 U.S.C. § 103

Claims 1, 3-13, 15-26 and 28-38 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over U.S. Patent No. 5,822,123 issued to Davis et al. (hereinafter Davis) in view of U.S. Patent No. 6,314,572 issued to LaRocca et al. (hereinafter LaRocca), and even further in view of U.S. Pub. No. 2003/0023980 to Kikinis et al. (hereinafter Kikinis).

Applicants respectfully submit that the limitations of amended independent claims 1, 13, and 26 are not taught or suggested by the Office Action's proposed 3-way combination of Davis, LaRocca, and Kikinis.

As noted by the Examiner on pages 7-8 of the Final Office Action, "Davis and LaRocca fail to teach:... recommending at least one bundle of channels for subscription by the user based upon a subscription matrix for the user, the selected program guide entry for the non-subscribed channel, and available bundles of channels for subscription." (emphasis added).

Accordingly, the Examiner attempts to combine Davis and LaRocca with Kikinis in order to re-create Applicants' claim limitations. Although Applicants continue to respectfully disagree with the characterization of the references set forth in the prior Office Action and with the previous rejection of the claims, in order to expedite the issuance of these claims, Applicants have amended independent claims 1, 13, 26, and 45 to more clearly define their subject matter over Kikinis.

Applicants respectfully submit that, even assuming, *arguendo*, that Davis and LaRocca were properly combinable and teach what the Office Action alleges they teach, their combination with Kikinis would still not teach or suggest Applicants' amended independent claims 1, 13, and

Appl. No. 09/920,583
Amdt. Dated 12/11/2006
Reply to Office action of 09/20/2006

26, which now generally recite: recommending at least one bundle of channels for subscription by the user based upon a subscription matrix for the user, the currently selected program guide entry for the non-subscribed channel displayed in the program guide, and available bundles of channels for subscription.

As set forth on page 3 of the Kikinis original provisional patent application, upon which the Office Action relies, Kikinis states that:

Figure 4 shows a process flow in a case for changing programming. It may be that the customer has, for example, seen a promotion offering a new programming package, or the customer may be prompted through an interactive ad to review his current subscription versus his actual usage pattern...

Based on the customer's history of program viewing and attempts to view programs, the system then makes a recommendation of packages in step 403. The process would then continue as in Figure 2, step 223. (Emphasis added).

As set forth above, it is clear that Kikinis relates to a process to up-sell promotional packages based upon a promotional offering or an interactive ad that the customer has selected. Previously viewed programs and attempts to view programs may be added into the recommendation analysis.

There is no teaching or suggestion in Kikinis of the client terminal recommending at least one bundle of channels for subscription by the user based upon a subscription matrix for the user, the currently selected program guide entry for the non-subscribed channel displayed in the program guide, and available bundles of channels for subscription.

In fact, there is no teaching or suggestion in Kikinis of basing a recommendation upon a currently selected program guide entry for a non-subscribed channel displayed in a program guide because Kikinis does not utilize a program guide to make recommendations.

Instead, Kikinis only teaches guided set-up procedures and allowing for programming changes through selected promotional offerings and interactive ads.

As described on page 1 of Kikinis: "Figure 1 shows a screen 100 that could appear when the user enters the set-up section of an interactive television device, typically a set-top box...Screen 100 has, for example, guided set-up options, such as "Initial Set-Up," "Move" (to help the customer change service when, for example, when he moves to another address), or

Appl. No. 09/920,583
Amdt. Dated 12/11/2006
Reply to Office action of 09/20/2006

"Counsel on New Promotions" which the customer could access if he sees advertisements for new packages and he's interested in learning more about them." Figures 2-4 and the associated text, upon which the Office Action relies, describe procedures to effectuate these guided set-up options and discuss the use of selectable promotional offerings and interactive ads.

Kikinis does not teach or suggest that, upon selection of a non-subscribed channel in a program guide, a bundle of channels is recommended by the client terminal based upon the currently selected program guide entry for the non-subscribed channel displayed in the program guide. Rather, the recommendation taught by Kikinis is presented in response to triggers such as a guided set-up procedure (e.g. when moving) or selecting a promotional offering or interactive ad.

Clearly, these limitations set forth in amended independent claims 1, 13, and 26 are not taught or suggested by Kikinis.

Thus, Applicants respectfully submit that the limitations of amended independent claims 1, 13, and 26 are clearly not taught or suggested by Kikinis in combination with Davis and in combination with LaRocca, and that these claims should be allowable. Applicants respectfully request that the Examiner allow independent claims 1, 13, and 26, and the claims that depend therefrom, and pass these claims to issuance.

Claims 45 and 47-52 stand rejected under 35 U.S.C. § 103(a) as being allegedly obvious over Davis in view of LaRocca, further in view of Kikinis, and even further in view of U.S. Patent No. 6,016,141 to Knudson et al. (hereinafter Knudson).

Knudson is merely cited to allegedly show a promotional display presented with a program guide.

However, Applicants respectfully submit that even this 4-way combination of references (Davis in view of LaRocca, further in view of Kikinis, and even further in view of Knudson) does not teach or suggest Applicants' amended claim limitations of independent claim 45 generally related to: a preference engine to create a user profile based upon user viewing preferences...a display interface to display a promotion display for a bundle of channels on the display device... wherein the promotion display is automatically presented as part of the program guide and is selected by the preference engine based upon the user profile.

Appl. No. 09/920,583
Amdt. Dated 12/11/2006
Reply to Office action of 09/20/2006

Kikinis does not teach or suggest a client terminal having a preference engine to create a user profile based upon user viewing preferences and the preference engine selecting a promotion display based upon the user profile. In fact, there is no teaching or suggestion of a preference engine, at all, in Kikinis.

The only discussion in Kikinis even remotely related to this aspect is that "the system" of Kikinis takes into account a customer's history of program viewing and attempts to view programs in recommending packages. (See page 3, paragraph 4, of Kikinis). There is no further description.

Clearly, there is no teaching or suggestion in Kikinis of a client terminal having a preference engine to create a user profile based upon user viewing preferences and the preference engine selecting a promotion display based upon the user profile.

For the above reasons, Applicants respectfully submit that Kikinis does not teach or suggest the claim limitations set forth in amended independent claim 45 and that amended independent claim 45, and the claims that depend therefrom, should be allowable. Applicants respectfully request that the Examiner pass these claims to issuance.

Appl. No. 09/920,583
Amdt. Dated 12/11/2006
Reply to Office action of 09/20/2006

RECEIVED
CENTRAL FAX CENTER

DEC 11 2006

Conclusion

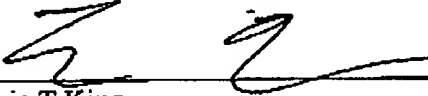
In view of the remarks made above, it is respectfully submitted that pending claims 1, 3-13, 15-26, 28-38, 45 and 47-52 are allowable over the prior art of record. Thus, Applicants respectfully submit that all the pending claims are in condition for allowance, and such action is earnestly solicited at the earliest possible date. The Examiner is respectfully requested to contact the undersigned by telephone if it is believed that such contact would further the examination of the present application. To the extent necessary, a petition for an extension of time under 37 C.F.R. is hereby made. Please charge any shortage in fees in connection with the filing of this paper, including extension of time fees, to Deposit Account 02-2666 and please credit any excess fees to such account.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 12/11/2006

By


Eric T King

Reg. No. 44,188

Tel.: (714) 557-3800 (Pacific Coast)

12400 Wilshire Boulevard, Seventh Floor
Los Angeles, California 90025

CERTIFICATE OF MAILING/TRANSMISSION (37 CFR 1.84)

I hereby certify that this correspondence is, on the date shown below, being:

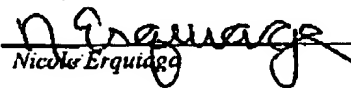
MAILING

FACSIMILE

☐ deposited with the United States Postal Service as first class mail in an envelope addressed to:
Commissioner for Patents, PO Box 1450,
Alexandria, VA 22313-1450.

☒ transmitted by facsimile to the Patent and Trademark Office.

Date: 12/11/2006


Nicole Erquidaga

12/11/2006

Date